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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,198	06/27/2001	Jerald C. Seelig	619.441	7098

7590

06/27/2002

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EXAMINER

NICOLAS, FREDERICK C

ART UNIT	PAPER NUMBER
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3754

DATE MAILED: 06/27/2002

#4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/894,198

Applicant(s)

SEELIG ET AL.

Examiner

Frederick C. Nicolas

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) 13-20 and 31-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 21-30 and 41-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-50 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2&3 6) ☐ Other: _____

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12,21-30,41-50, drawn to an animated gaming system, classified in class 463, subclass 30.
 - II. Claims 13-20, drawn to a method for operating an animated gaming device, classified in class 463, subclass 1.
 - III. Claims 31-40, drawn to a method for playing a gaming system, classified in class 463, subclass 4.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the method for operating an animated gaming device can be practiced with other patentable distinct device such as a hand held wheel of fortune gaming device.

3. Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the method for

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playing a gaming system can be practiced with other patentable distinct system, such as a play station gaming system.

4. Inventions III and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because a wireless gaming device will communicate with the animated gaming system. The subcombination has separate utility such as a controller for a play station.

5. During a telephone conversation with the applicant's attorney Mr. Rolando J. Tong on 6/13/2002 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-12,21-30,41-50. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-20,31-40 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

7. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed subject matter in claim 8, lines 1-2, "an additional animated figure within said housing", and the claimed subject matter in claim 9, lines 1-2, "an additional animated element within said housing" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-12,21-30,41-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly et al. (U.S 5,584,763) in view of Stotler (U.S 1,257,045).

Kelly et al. discloses a gaming system as best seen in Figure 1, which comprises a housing for the gaming system (see Figure 1 for location of the housing), the housing has at least one symbol (45) which represents at least one prize, a figure (42a) having a three-dimensional form (note: it is inherent that the figure has a three-dimensional form), an element (42b) operatively coupled to the figure, the element is configured to identify

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the at least one prize (column 4, lines 46-58), the at least one prize is a monetary award (column 3, lines 23-31), a processor (110) is configured to generate a random number which determines the location of the element, a token input (28), a first gaming device (14), the gaming system is configured to receive communications from the first gaming device (column 3, lines 42-51), a housing is configured to house the first gaming device and the animated gaming system as best seen in Figure 1, the first gaming device further comprises a first gaming device output which is communicated to the processor (column 8, lines 9-13), a transducer in communication with the processor (column 8, lines 40-63). Kelley et al. lacks the figure being animated including the element. Stotler teaches the use of an animated gaming system as best seen in Figure 1, which comprises an animated figure (G), an animated element (see Figure 1 for location), where the animated element is configured to identify at least a prize (column 2, lines 13-44).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the figure of Kelley et al. with the animated figure of Stotler, in order to provide an animated indicated device.

Re claim 8, the claimed subject matter, "the animated gaming system further comprises an additional animated element within the housing", as well as the claimed subject matter in claim 9. It would have been obvious to one having ordinary skill in the art at the time the invention was made to duplicate the animated figure including the animated element of Kelley et al., since it has been held that mere duplication of the

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essential working parts of a device involves only routine skill in the art. As per MPEP

2144.04

Conclusion

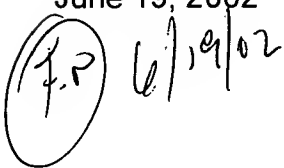
10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Okitani et al., Poole, Ferris et al., Goldfarb et al., DeMar et al., Jaffe, Weiss, Seelig et al., Steadman, Michael, Brossard, Marta, Miyamoto et al., Adams, Morris and Frederick disclose other types of animated gaming system.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick C. Nicolas whose telephone number is (703)-305-6385. The examiner can normally be reached on Monday - Friday from 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry C. Yuen, can be reached on (703) 308-1946. The fax phone number for the organization where this application or proceeding is assigned is (703)-308-7766.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0861.

FN
June 19, 2002




Lesley D. Morris
Primary Examiner
Au 3752